

In re Application of:

SHINICHI SATO, et al.

Application No.: 09/994,724

Filed: November 28, 2001

For: INK, INK-JET INK, INK TANK, INK-JET
CARTRIDGE, INK SUPPLY DEVICE,
METHOD FOR INTRODUCING INK TO
INK TANK AND IMAGE RECORDING
DEVICE

THE COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Response in the above-identified application.

☒ No additional fee is required.

The fee has been calculated as shown below

CLAIMS AS AMENDED						
	(2) CLAIMS REMAINING AFTER AMENDMENT		(4) HIGHEST NO. PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL CLAIMS	* 24	MINUS	** 35	= 0	x \$9 \$18	- 0 -
INDEP. CLAIMS	* 4	MINUS	*** 6	= 0	x \$43 \$86	- 0 -
Fee for Multiple Dependent claims \$145°/\$290						
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT---						- 0 -

* If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.

** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

- ☐ Verified Statement claiming small entity status is enclosed, if not filed previously.
- ☐ A check in the amount of \$_____ is enclosed.
- ☐ Charge \$_____ to Deposit Account No. 06-1205. A duplicate copy of this sheet is enclosed.
- ☒ Any prior general authorization to charge an issue fee under 37 C.F.R. 1.18 to Deposit Account No. 06-1205 is hereby revoked. The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. 1.16 and 1.17 which may be required during the entire pendency of this application, or to credit any overpayment, to Deposit Account No. 06-1205. A duplicate copy of this paper is enclosed.
- ☒ A check in the amount of \$ 110.00 to cover the fee for a one month extension is enclosed.
- ☐ A check in the amount of \$_____ to cover the Information Disclosure Statement fee is enclosed.
- ☒ Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should continue to be directed to our address given below.

Respectfully submitted,


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Form #120

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: M. Nghiem
SHINICHI SATO, et al.)
: Group Art Unit: 2861
Application No.: 09/994,724)
: Filed: November 28, 2001)
: For: INK, INK-JET INK, INK TANK,)
: INK-JET CARTRIDGE, INK)
: SUPPLY DEVICE, METHOD FOR)
: INTRODUCING INK TO INK)
: TANK AND IMAGE RECORDING)
: DEVICE : May 12, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION
AND
SUBMISSION OF SWORN TRANSLATION

Sir:

This is in response to the Office Action dated January 12, 2004, the period
for response to which having been extended to May 12, 2004 by the accompanying Petition
For Extension Of Time.

I hereby certify that this correspondence is being deposited with the
United States Postal Service as first-class mail in an envelope addressed
to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-
1450 on

May 12, 2004
(Date of Deposit)

Michael K. O'Neill, Reg. No. 32,622
(Name of Attorney for Applicant)

Signature

May 12, 2004
Date of Signature

This application has been carefully reviewed in light of the Office Action dated January 12, 2004. Claims 1 to 7, 9 to 18 and 25 to 31 are in the application, of which Claims 1, 25, 26 and 31 are independent. Reconsideration and further examination are respectfully requested.

An earlier objection to the specification was maintained, based on the language of Claim 18. Relatedly, all of Claims 1 to 7, 9 to 18 and 25 to 31 were rejected under 35 U.S.C. § 112, first paragraph. According to this objection and rejection, the language of Claim 18 is inconsistent with the disclosure in Figure 12 since Figure 12 allegedly shows pump B304 reducing pressure through suction port B123 and not through air outlet B410. As explained more fully at page 10 of the Office Action, the Examiner has apparently taken the position that suctioning by suction pump B304 might very well affect airflow through air outlet B410, but suction pump B304 only suctions air through suction port B123 and not through air outlet B410.

The objection and rejection are respectfully traversed, since they both ignore connectedness in the arrangement shown in Figure 12. As explained at lines 1 through 9 of page 26, which describes the arrangement shown in Figure 12 and includes a reference to Figure 8, air outlet B410 is in communication with suction port B123:

“Each air outlet B410 of the subtank B400 is in communication with a common air suction port B123 (see Figure 8) formed at the downward face of the carriage B104, as described above. This air suction port B123 can be connected to a supply joint B302 installed at the body of the printing unit B100 when the carriage B104 moves to the home position, thereby connected [sic, connecting] to one of the cylinder chambers of the pump cylinder B304 via the supply joint B302 and the supply tube B303.”

This description is perfectly consistent with the language of Claim 18, which clearly specifies that a suction pump reduces “a pressure in the ink container through the ink outlet”.

The position taken by the Office Action, that suction pump B304 only reduces pressure through suction port B123 and not through air outlet B410, ignores this connectedness. In fact, taken to the extreme, the position taken by the Office Action is inconsistent with Applicants’ disclosure of their invention, since suction port B304 actually initiates its suction activity at the proximal end of supply tube B303, whereupon the suction continues through to the distal end of supply tube B303, entering and exiting supply joint B302, and thence to suction port B123. Hence, the rejection recognizes the connectedness between suction pump B304 and suction port B123, but for some reason ignores the same connectedness between suction port B123 and air outlet B410.

In view of the connectedness shown in Figure 12, which is described fully in the specification such as at the aforementioned page 26, it is believed that the objection and rejection are erroneous and should be withdrawn.

Claims 26 to 31 were rejected under 35 U.S.C. § 102(e) over U.S. Patent 6,540,321 (Hirano). The rejection is respectfully traversed, since the rejection improperly mixes different embodiments of Hirano and thus could not properly be entered under § 102.

Specifically, the rejection of independent Claims 26 and 31 relies, for the most part, on Hirano’s Figures 12 through 17. Figures 12 through 17 illustrate Hirano’s third embodiment (actually, all of Figures 9 through 17 show Hirano’s third embodiment).

However, for the claimed feature of “surface processing”, the Office Action relies on language found at lines 37 to 39 of column 40, which forms part of Claim 1. Claim 1 includes a “space” provided between the gas-liquid separating means and the ink absorber”, which is not a feature found anywhere in Hirano’s third embodiment. Rather, Hirano’s claimed feature of a “space” is found in other embodiments, such as the seventh embodiment (Figures 25 through 27). Thus, the rejection is erroneous since it is based on a combination of embodiments, such that the elements shown in Hirano are not arranged identically as in the rejected claims.

MPEP § 2131 correctly summarizes the factual predicates needed to enter a rejection for anticipation under § 102. As correctly stated there, anticipation under §102 is a strict word-for-word identity test in which a single prior art reference must show, with word-for-word identity, every element of the invention, with all of those elements arranged exactly as in the claim. Relying on *In re Bond*, 15 USPQ2d 1566 (Fed. Cir., 1990), MPEP § 2131 admonishes that:

“The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.”

Here, the elements of Hirano are not arranged identically as in the rejected claims. Rather, the rejection is premised on a combination of a third embodiment of Hirano with a seventh embodiment thereof, which very clearly is not “arranged as required by the claim”.

Accordingly, the § 102 rejection of Claims 26 to 31 is founded on an incorrect factual predicate, and must be withdrawn.

Turning to the remaining claims, Claims 1 to 4, 6, 9 to 16, 18 and 25 were rejected under 35 U.S.C. § 103(a) over Hirano in view of U.S. Patent 5,509,140 (Koitabashi), and Claim 5 was rejected further in view of U.S. Patent 5,663,754 (Lorenze). The rejections are respectfully traversed, on multiple grounds.

First, as pointed out above, reliance on Hirano is based on an improper combination of different embodiments of the Hirano patent. In the context of this rejection under § 103, as opposed to the foregoing rejection under § 102, no attempt was made in the Office Action to justify this combination and to provide evidence that one of ordinary skill would have been motivated to combine these different embodiments.

Second, reliance on Hirano in the context of a rejection under § 103 is improper in view of the provisions of 35 U.S.C. § 103(c) for the reason that, at the time of the invention of the subject application, Hirano and the claimed invention were commonly owned by Canon Kabushiki Kaisha or subject to an obligation of assignment to Canon Kabushiki Kaisha. Pursuant to MPEP § 706.02(l)(2), the following conspicuous statement is made:

Hirano and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Withdrawal of the § 103(a) rejection is therefore respectfully requested.

It is possible that foreign counterparts to Hirano might have been published before the U.S. filing date to the subject application, although it is Applicants' understanding that all of those foreign counterparts were published after the priority date

for the instant application. Accordingly, to perfect Applicants' claim to foreign priority, submitted herewith is a sworn translation of Japanese Application No. 2000-363685 filed in Japan on November 29, 2000. Pursuant to MPEP § 201.15, the Examiner should confirm for himself that Applicants are entitled to their claim for foreign priority.

In view of the foregoing, it is believed that the entire application is fully in condition for allowance, and such action is courteously solicited.

Applicants' undersigned attorney may be reached in our Costa Mesa, California office by telephone at (714) 540-8700. All correspondence should continue to be directed to our address given below.

Respectfully submitted,


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